

REMARKS

Claims 1-4, 11-13, 15, 17-20, 23-32 and 34 are pending herein. Claims 5-10, 14, 16, 21, 22 and 33 have been cancelled, thereby removing these claims from further consideration in the case. Claims 1-32 have been rejected and claims 33 and 34 objected to, the Examiner indicating that the latter two claims would be allowed if rewritten in independent form.

The Examiner first rejected claims 1-4, 17-20, 30 and 32 under 35 USC 102(b) as anticipated by the patent to Byard (US 2,618,779). The Examiner will note that applicant's independent claim 1 has been amended to include a handle and a hand guard provided on the handle for shielding the hand from a force applied to the plunger element of the apparatus. Claims 2-4 depend from claim 1 as so amended, as do claims 17-20. Independent claim 30 has also been amended to include a handle reversibly carried by the head apparatus of applicant's device and claim 32 depends from applicant's dependent claim 31, which depends from applicant's claim 30 as so amended. Claim 32 includes a staple rail removably mounted in the magazine and a spacer provided on the magazine cover for stabilizing the staples on the staple rail.

The Examiner's rejection of claims 1-4, 17-20, 30 and 32 as so amended, is respectfully traversed as follows. Reference is made to MPEP Chapter 2131, which states that in order for a reference to anticipate a claim "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson vs. Suzuki Motor Co.*, 9 USPQ 2nd 1913, 1920 (Fed.Cir.1989). MPEP Chapter 2131 continues, "The elements must be arranged as required by the claim ...". *In re Bond*, 15 USPQ 2nd 1566 (Fed.Cir. 1990). It is respectfully submitted that the Byard patent fails to show the "identical invention" as that defined by each of applicant's amended claims 1-4, 17-20, 30 and 32, as required for anticipation by the Federal Circuit in

Richardson vs. Suzuki Motor Co. and further, that the elements of the Byard patent are not arranged as required by applicant's claims, also required for anticipation by the Federal Circuit *In Re Bond*, since the Byard patent fails to include a handle as set forth in applicant's amended claims. In contrast, the Byard patent is simply gripped by the cover with the stapling head in position for driving the staples, without the requirement or necessity of a handle. Accordingly, it is respectfully submitted that applicant's amended claims 1-4, 17-20, 30 and 32 are not anticipated by the Byard patent and reconsideration and allowance of applicant's claims 1-4, 17-20, 30 and 32 as amended, is therefore respectfully solicited.

The Examiner further rejected claims 5, 7-9, 11-15, 21, 23, 25-28 and 31 under 35 USC 103(a) as unpatentable over the patent to Byard, U.S. 2,168,779, taken in view of the patent to Landrus, U.S. 4,380,312. The Examiner will note that claims 7-9, 14, 15 and 21 have been cancelled, thereby removing these claims from further consideration in the case. Remaining claims 11-13 depend from applicant's amended claim 1, while remaining claims 25-28 depend from applicant's independent claim 23 and claim 31 depends from applicant's independent amended claim 30. The Examiner noted that Byard shows a hammer stapling apparatus for driving staples which has a magazine, a head apparatus, a staple rail and a spring-biased plunger. The Examiner further noted that Landrus teaches a stapling apparatus having a magazine, a head apparatus, a pair of spacers, a staple rail, a spring biased plunger and a "handle attached to a head apparatus". A close review of the Landrus patent reveals that the Landrus handle is not attached to the head apparatus as required by applicant's claims, both amended and original. Instead, reference to FIGURE 1 of the Landrus patent shows clearly that the handle is attached to the solenoid driver 16 and pivotally to the staple cover or staple body, but not to the head assembly. Accordingly, it is respectfully submitted that one skilled in the art, when reviewing

the Byard patent and the Landrus patent in combination, would not be led to the conclusion that a handle would reasonably be extended from the head element of the Byard apparatus, for several reasons: first of all, the Byard patent requires no such handle and there is no teaching, suggestion or disclosure of a handle in the Byard patent or of the necessity of having one. Secondly, the Landrus patent teaches attaching a handle to the solenoid driver 16 above the head mechanism and would not, therefore, lead someone of ordinary skilled in the art to conclude that one could attach a handle to the Byard stapling head apparatus. Indeed, there is nothing in the Landrus design to suggest or teach redesigning of the Landrus and Byard patented staplers, or either of them, to provide a handle attachment to the head assembly, rather than to the solenoid driver, as disclosed in Landrus. MPEP Chapter 2143, beginning on p.2100 reads as follows: To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Furthermore, the teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure *In re Vaeck*, 20 USPQ 2nd 1438, (Fed.Cir.1991) and *In Re O'Farrell*, 7 USPQ 2nd 1673 (Fed.Cir. 1988).

It is respectfully submitted that there is no reasonable suggestion or motivation for the reasons outlined above in either Byard or Landrus for applying the Landrus handle to the Byard stapling head, since the two devices are designed in such a different manner. Byard requires no handle at all, while Landrus requires that the handle be attached to the solenoid driver and not to

the stapling head. Accordingly, one skilled in the art would have no reason to use the Landrus handle with the Byard stapler as claimed in applicant's remaining claims 11-13, 23, 25-38 and 31. Furthermore, it is respectfully submitted that there is no reasonable expectation of success should the Landrus handle be joined to the stapling head of the Byard patent, because there is no disclosed manner in which this mechanical arrangement can be accomplished, considering the design of the Byard patent and the Landrus handle. Since the Landrus handle must be attached to the solenoid driver itself, there is no disclosed manner or suggestion in either of these patents for using the patented devices together to accomplish this result.

This observation leads to the second criteria for establishing a prima facie case of obviousness noticed in MPEP Chapter 2143; that the teaching or suggestion to make the claim combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure. It is respectfully submitted that the Examiner is applying hindsight in the application of the Landrus handle to the Byard stapler, since, as noted above, there is no suggestion or teaching for doing so in either of these two reference patents. There appears to be no reason why one skilled in the art, upon reading both of these patents, would conclude that the Landrus patent could be applied to the Byard stapler, since the Byard stapler needs no handle to begin with. It is clear that the mere fact that references can be combined or modified does not render the result of combination obviousness unless the prior art also suggests the desirability of the combination. *In Re Mills*, 16 USPQ 2nd 1430 (Fed.Cir.1990). The Federal Circuit case law makes it clear that the best defense against the subtle, but powerful, attraction of hindsight-based obviousness analysis, is vigorous application of the requirement for showing of the teaching or motivation to combine prior art references. *C.R. Bard, Inc., vs. M 3 Systems, Inc.*, 48 USPQ 1225, 1232 (Fed.Cir.1998). It is respectfully submitted that there is no such

motivation or suggestion of any such combination desirability in either the Byard or the Landrus patents. Accordingly, it is respectfully submitted that applicant's remaining claims 11-13, 23, 25-28 and 31 are not made obvious by the Byard and Landrus patents, taken alone or in combination, within the reasonable contemplation of 35 USC 103(a). Reconsideration and allowance of claims 11-13, 23, 25-28 and 31 is therefore respectfully solicited.

The Examiner further rejected claims 6, 10, 16, 22, 24 and 29 under 35 USC 103(a) as unpatentable over the patent to Byard, U.S. 2,618,779, taken in view of the Landrus patent, U.S. 4,380,312, further taken in view of the patent to Dvorak, et al, U.S. 5,699, 864. The Examiner noted that the Dvorak, et al patent teaches an impact device having a handle 86 with a handle guard 94. He further noted that it would be obvious to one having ordinary skill in the art at the time of the invention to further modify the apparatus of Byard to include the handle guard of Dvorak, et al, for the purpose of guarding the hand during use of the apparatus. Dvorak, et al (col.6, lines 11-13).

The Examiner will note that applicant's claims 6, 10, 16 and 22 have been cancelled and remaining claims 24 and 29 depend from applicant's independent claim 23. Claim 23 recites a hammer-operated stapling apparatus which includes a handle carried by the head for positioning the head while driving the staples from the head. Claim 24 recites a hand guard provided on the handle for shielding the hand from the application of force on the plunger and claim 29 includes the recitation of a hand guard reversibly provided on the handle for shielding the hand from application of force on the plunger and a plunger spring provided on the plunger for urging the plunger away from the hand apparatus.

An analysis of the Landrus patent is included above. A close review of the Dvorak patent reveals that this patent is drawn to a marine anchoring apparatus which includes an

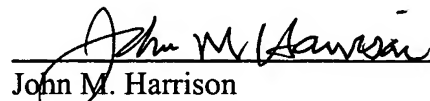
elongated spike or stake provided with an impact handle slidably arranged on the stake, with a flexible handle strap 94 attached to the impact handle to maintain the hand in place on the impact handle and “prevent any portion of the hand from coming into contact with the impact area, hence, preventing injury.” It is clear from a reading of the Dvorak patent that the handle strap 94 is designed to prevent the hand from coming off of the impact handle when the impact handle is used to drive the stake into the ground and not to protect the hand from external striking forces, as in the case of applicant’s invention as embodied in his remaining claims 24 and 29. It is respectfully submitted that the impact “hammer” 98 which is gripped by the hand is certainly not analogous to the staple gun handle detailed in the Landrus patent and the handle detailed in the Landrus patent is not suggestive in any way of applicant’s handle extending from the head apparatus detailed in his independent claim 23 and claims 24 and 29, as discussed above. Accordingly, it is respectfully submitted that one skilled in the art could scarcely glean from the Dvorak patent any reasonable insight as to application of the Dvorak resilient strap 94 to applicant’s invention as embodied in his claims 24 and 29, particularly, since the Landrus handle is not even attached to the head member, as required by applicant’s claims 24 and 29, but is, instead, attached directly to the solenoid driver 16, as detailed above. Accordingly, it is further respectfully submitted that there is no reasonable suggestion or motivation in either the Landrus patent or the Dvorak patent for applying the Dvorak strap, mounted on the hammer of an impact device, to applicant’s invention as embodied in claims 24 and 29, since the devices operate in such a different manner. One skilled in the art would further have no reason to use the Dvorak protective strap on applicant’s handle because there is no teaching or suggestion of using such a strap in combination with the Landrus and Byard patents, and secondly, because application of such a strap to the invention defined in applicant’s claims 24 and 29 would be ineffective for the

purpose intended. Striking of such a strap provided on the handle of applicant's device would not measurably protect the fingers or hand of a user gripping the handle, since the strap is not rigid nor large enough for the intended protection. Accordingly, it is respectfully submitted that the Examiner is applying hindsight in the application of the Dvorak patent and Landrus patent to the Byard stapler, since there is no suggestion or teaching to do so any of these patents, see *In re Mills*, 16 USPQ 2nd 1430 (Fed.Cir. 1990). Accordingly, it is respectfully submitted that applicant's claims 24 and 29 are not made obvious by the Byard, Landrus and Dvorak patents, taken alone or in combination, and reconsideration and allowance of claims 24 and 29 as well as claim 23, from which these two claims depend, is respectfully solicited.

The Examiner indicated that claims 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims. The Examiner will note that claim 33 has been restated in independent claim 30, while claim 34 has been amended to depend from claim 30. Reconsideration and allowance of claims 30 and 34 as amended, is respectfully requested.

Every effort has been made to amend applicant's claims in order to define his invention in the scope to which it is entitled. Accordingly, reconsideration and allowance of applicant's remaining claims 1-4, 11-13, 15, 17-20, 23-32 and 34, as amended and originally presented respectfully, is respectfully solicited.

Respectfully submitted,



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